

Patent
Application No. 09/843,150
Atty. Dkt. No. 065691/0219

REMARKS

Status of the Claims:

Claims 1 and 54 are currently amended, and claims 2-4 are canceled, without prejudice or disclaimer. Claims 1, 5-6, 8-13, 15-24, 26-46, and 49-54 are pending, and elected claims 1, 5-6, 8-13, 15-24, and 53-54 should be examined. Claims 26-46 and 49-52 are withdrawn but should be rejoined when the base claims are allowable. Claims 3, 5, 5, 8-13, 19-24, and 53-54 were objected to.

The Examiner is thanked for indicating the allowable subject matter.

Claim Objection:

Claim 54 was objected under 37 C.F.R. §1.75(c), for alleged improper dependent form. See Office Action, page 2. The present version of claim 54 avoids this objection and adopts the Examiner's suggestion to make it independent. Thus, the amendment should be entered, and the objection should be withdrawn.

Rejections - 35 U.S.C. § 102(b)

Claims 1-2, 4, and 15-18 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Wild et al. (A6 Reference; Gene 1998, vol. 223, pages 55-66). Applicants respectfully traverse this rejection.

A reference anticipates a claim only if that reference explicitly or inherently describes each and every element of the claim. MPEP § 2131. If even just one element is absent from the reference's particular disclosure, that disclosure neither describes nor anticipates the claim. *Id.* Such is the case in this rejection.

According to the Office, Wild et al. discloses retrofitting pre-existing libraries of transposon insertions with FRT and ori V elements for generating large quantities of genomic

Patent
Application No. 09/843,150
Atty. Dkt. No. 065691/0219

DNA fragments. Office Action, page 3. The PTO alleges "Wild et al demonstrate the generation of isolated DNAs comprising recombination sequences in the order of Lox-FRT-Lox-FRT...." Office Action, page 3. Specifically, the PTO asserts "In this example the Lox sequences flank, at least, the first FRT sequence, and the FRT sequences flank the second Lox sequence as well as genomic sequences." Office Action, page 3.

On one hand, the instant invention claims "5'-L1-L2-sequence A-sequence B-L1-L2-3'." Yet on the other hand, Wild discloses that the FRT sequences flank the second Lox sequence. See Wild et al. Figure 7. For this reason alone, Wild would not anticipate the invention. Accordingly, the rejection should be withdrawn.

CONCLUSION


As the above-presented amendments and remarks address and avoid each objection and rejection presented by the Examiner, withdrawal of each objection and rejection and allowance of the claims are respectfully requested. No new matter has been added.

If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

Date October 28, 2004

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

By  (45,943)
SEAN A. PASSINO
Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees, and applicants hereby petition for any needed extension of time.